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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,595	02/11/1999	BRIAN FEENEY	P-5761-SPALD	8963
24492	7590	01/25/2005	EXAMINER	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD LEGAL DEPT CARLSBAD, CA 92008-7328			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 01/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/248,595  
Filing Date: February 11, 1999  
Appellant(s): FEENEY ET AL.

**MAILED**  
**JAN 25 2005**  
**GROUP 3700**

Richard M. Klein & Mark E. Bandy  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 08 November 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

There is only one claim at issue. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. *Appellant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention.* Appellant has mentioned in the specification (page 10) several suitable leathers, which are commercially available, but has failed to disclose the particular tanning process which was used to produce the “increase water resistant properties” in the natural leather or that at the time of filing of this application applicant was in possession of this information? Therefore, it is unclear how the unexpected results have been reached, since one skilled in the art will not be able to make or use appellant’s invention as originally filed without knowing the particular tanning process used.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as filed does not provide support for a game ball without a bladder (see Table 1B and 2B) so as to meet the appealed claim. Appellant has failed to sufficiently disclose how to make the invention as claimed, particularly the tanning process and a ball without a bladder, so as to

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meet the claimed limitation. The process set forth in the apparatus claim only finds support (other than the tanning process) with a ball having the leather, the lining and the bladder. Since Appellant refuses to acknowledge that appealed claim 3 may only be reasonably read on the ball with the bladder, one ordinary skilled artisan would not be able to reasonably make the claimed invention so as to meet the characteristics set forth therein without undue experimentation when making the ball without a bladder. The game balls used to conduct the rain test in Example 1 having a cover, a lining and a bladder, and in Comparative Example 1, the game ball having a Cover and a bladder. No information has been provided to lead one to believe that additional rain tests were conducted for game balls not having a bladder. It is unclear how the claimed ranges were obtained, since there are no tables to support such limitations. It is not readily apparent from the claim language that a bladder is present for the claimed game ball. Absent the bladder, appellant has no support for the claimed characteristics of the ball.

***(11) Response to Argument***

For the above reasons, it is believed that the rejections should be sustained.

With regards to Appellant's assertions on the drawing objections. This issue relates to petitionable subject matter and it is not an appealable subject matter. See MPEP 1002 and 1201. Nevertheless, it should be noted that Appellant's assertions are unfounded. The Specification and charts support a game ball having a cover, a lining and a bladder (Table 1B) or a game ball having a cover and a bladder (Table 2B). Claim 3 is directed towards a ball having a cover and a lining with no bladder. Such is not supported. The drawings only show the game ball of Table 1B. In any event there is not support in the disclosure as filed for the claimed limitation of claim 3.

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As indicated in the Final Office Action, Appellant's comments regarding the claimed range in claim 3, is not understood, since the claimed range in claim 3 was never an issue. With regards to Appellant's assertion that the specification as originally filed provides the requisite written description for the claimed property, and that support can be found on page 10, line 23 of the application, such assertion is not founded. The specification as filed merely states that "a game ball of the present invention having a leather cover and a lining is subjected to the "rain test" for a period of 45 minutes, the ball would absorb a limited amount of water . . . , that ratio would be in the range of 1.01:1 to 1.2:1. . . Preferably, . . . 1.01:1 to 1.15:1. This is all the information that is provided. There is no additional information provided in the specification, charts or drawings as to the claimed limitations "six 45 minute cycles of rain test . . ." resulting a ration of 1.20:1. The number of cycles and the achieved ratio applies to the inventive game ball having a cover, lining and a bladder. Such is clearly shown on page 11 lines 2-21 of the specification as filed. No support for the claimed limitation is found without a bladder.

With regards to Appellant's assertion that the Examiner demands exact scientific explanation, again, as indicated in the prior actions, such is not the case. Throughout the prosecution of this application, Appellant has asserted that the leather and the particular tanning process is the key to this invention. However, Appellant has merely referred to several suitable leathers, which are commercially available, but has failed to disclose the specific tanning process which has been used to produce the "increase water resistant properties" in the well-known natural leather. Since Appellant asserts that the particular tanning process yields this unexpected result, therefore, it should be disclosed as to what particular process was used to achieve these results.

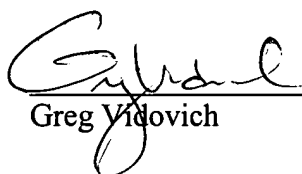
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Respectfully submitted,

MA

January 21, 2005

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